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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,793	09/08/2000	Wesley H Verkaart	70869-0068US	6666
22902	7590	09/28/2009		
CLARK & BRODY 1090 VERMONT AVENUE, NW SUITE 250 WASHINGTON, DC 20005			EXAMINER SIEFKE, SAMUEL P	
			ART UNIT	PAPER NUMBER
			1797	
			MAIL DATE	DELIVERY MODE
			09/28/2009	PAPER

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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WESLEY H. VERKAART,
LIN A. JAKARY, LOU BLASETTI, AND
STEVEN M. GANN

Appeal 2009-006633
Application 09/623,793
Technology Center 1700

Decided: September 28, 2009

Before BEVERLY A. FRANKLIN, LINDA M. GAUDETTE, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1, 3-10, and 15-19. The Examiner has withdrawn the rejection of claims 4 and 8-10. Ans. 3. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

STATEMENT OF THE CASE

Claims 1, 5, 18, and 19 are representative of the subject matter on appeal and are set forth below:

1. Apparatus for transferring a fluid to a sterile field comprising a casing having a first part and a second part, wherein said casing is configured to receive a syringe containing said fluid and maintain sterility of said syringe when said first part is connected to said second part, said syringe may be removed from said casing when said first part is disconnected from said second part, said first part is adapted to receive a barrel portion of said syringe and allow sterile, fluid communication with said syringe from a non-sterile field outside said casing, said second part is adapted to receive a plunger portion of said syringe, and said second part is flexible in the direction of movement of said plunger and configured to allow a user to engage and manipulate said plunger when said syringe is in said casing and said first and second parts are connected, wherein said first part includes a connector that detachably engages a tip of said syringe and allows said fluid communication between said syringe and the exterior of said casing, and said first part is readily detachable from said second part.

5. Apparatus according to claim 1 wherein said second part is made of a thin flexible sheet.

18. Apparatus according to claim 3 wherein said rigid tube includes gripping elements.

19. Apparatus according to claim 5 wherein said flexible sheet allows a user to grasp said syringe through said flexible sheet.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Esposito

5,997,811

Dec. 7, 1999

THE REJECTION

Claims 1, 3, 5-7, and 15-19 are rejected under 35 U.S.C. § 102(e) as anticipated by Esposito.

ISSUE

Have Appellants shown reversible error in the Examiner's determination that Esposito anticipates the subject matter of claims 1, 5, 6, 18, and 19, as argued by Appellants?

PRINCIPLES OF LAW

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997).

When the reference is a utility patent, it does not matter that the feature shown is unintended or unexplained in the specification. The drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. *In re Aslanian*, 590 F.2d 911, 913-14 (CCPA 1979).

After evidence or argument is submitted by the Applicant in response to an Examiner's rejection, patentability is determined on the totality of the record, by a preponderance of evidence (that it is more likely than not), with due consideration to persuasiveness of argument. *In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985); *In re Johnson*, 747 F.2d 1456, 1460 (Fed. Cir. 1984).

Arguments of counsel cannot take the place of factually supported objective evidence. *See, e.g., In re Huang*, 100 F.3d 135, 139-40 (Fed. Cir. 1996); *In re De Blauwe*, 736 F.2d 699, 705 (Fed.Cir. 1984).

FINDINGS OF FACT

Esposito's Figure 2 indicates flexibility in the sheath. The thermoplastic material can be peeled open. Esposito, col. 5, ll. 2-17.

Claim 18 requires that the gripping elements are on the casing (on the rigid tube which is first part 4 as shown in Figure 2) and not on the syringe. This aspect of Appellants' claimed invention is depicted in Figure 2 as element 22.

ANALYSIS

As an initial matter, we limit our consideration to the claims specifically argued by Appellants, which are claims 1, 5, 18, and 19. 37 C.F.R. § 41.37(c)(1)(vii).

With respect to claim 1, Appellants argue that Esposito does not disclose that the second part of the casing is flexible in the direction of movement of the plunger and is configured to allow a user to engage and manipulate the plunger when the syringe is in the casing. Appellants also argue that Esposito discloses that the sheath is made of thermoplastic, but that this does not mean that the sheath is flexible. Br. 11; Reply Br. 1.

We are not convinced by the aforementioned arguments for the following reasons.

First, we refer to the Examiner's finding that Figure 2 of Esposito indicates flexibility in the sheath. Ans. 5. The drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. *In re Aslanian*, 590 F.2d at 913-14. This finding is further supported by the fact that the thermoplastic material can be peeled open. Esposito, col. 5, ll. 2-17. On the other hand, Appellants point to no facts indicating that the thermoplastic material is not flexible, but merely provide attorney argument, which cannot take the place of factually supported objective evidence. *In re Huang*, 100 F.3d at 139-40; *In re De Blauwe*, 736 F.2d at 705.

Hence, based upon the totality of the record, by a preponderance of evidence (that it is more likely than not), with due consideration to persuasiveness of argument, we agree with the Examiner's position that the sheath of Esposito is flexible as claimed by Appellants. *In re Caveney*, 761 F.2d at 674; *In re Johnson*, 747 F.2d at 1460.

Second, because the sheath of Esposito is flexible, we agree with the Examiner that the claimed aspect of Appellants' claim 1 that the user can "engage and manipulate the plunger" while in the casing (sheath), is anticipated by Esposito. We refer to the Examiner's response made on page 6 of the Answer in this regard. Also, as stated by the Examiner on pages 4-5 of the Answer, claim 1 of Esposito recites that the package receives and encases the syringe "while permitting operation of the syringe." Appellants argue that this "operation" is not the kind of operation as claimed. However, given that the sheath of Esposito is flexible, we cannot agree with Appellants' conclusion here.

With regard to claim 5, Appellants repeat their position that Esposito fails to disclose that the thermoplastic material is flexible. We refer to our

analysis, *supra*, on this issue, and therefore agree with the Examiner's position with respect to these claims.

With regard to claim 19, in connection with the recited phrase the "flexible sheet allows a user to grasp said syringe through said flexible sheet," we again agree with the Examiner's position because the sheath of Esposito is flexible which would allow for such grasping.

With regard to the claim 18 phrase "wherein said rigid tube [of claim 3] includes gripping elements," we agree with Appellants that the Examiner's position as set forth on page 7 of the Answer is not correct because claim 18 requires that the gripping elements are on the casing and not on the syringe. Reply Br. 2.

CONCLUSIONS OF LAW

Appellants have not shown reversible error in the Examiner's determination that Esposito anticipates the subject matter of claims 1, 5, 6, and 19, as argued by Appellants.

Appellants have shown reversible error in the Examiner's determination that Esposito anticipates the subject matter of claim 18.

DECISION

The rejection of claims 1, 3, 5-7, and 15-17, and 19 under 35 U.S.C. § 102(e) as anticipated by Esposito is affirmed.

The rejection of claim 18 under 35 U.S.C. § 102(e) as anticipated by Esposito is reversed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED-IN-PART

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